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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/771,054 | 01/26/2001 | Richard A. Mallo | 56147USA8A.002 | 7236 |
| 7590 | | 12/27/2006 | EXAMINER | |
| Attention: Yen Tong Florczak | | | FUBARA, BLESSING M | |
| Office of Intellectual Property Counsel | | | ART UNIT | PAPER NUMBER |
| 3M Innovative Properties Company | | | 1618 | |
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| St. Paul, MN 55133-3427 | | | | |
| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE | | |
| 3 MONTHS | 12/27/2006 | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | | |
|------------------------------|--------------------|--------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/771,054 | MALLO ET AL. |
| | Examiner | Art Unit |
| | Blessing M. Fubara | 1618 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 11 October 2006.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 29-43 is/are pending in the application.
- 4a) Of the above claim(s) 37 and 42 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 29-38, 38-41 and 43 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Examiner acknowledges receipt of response to election requirement filed 10/11/06.

Claims 29-43 are pending.

Response to Arguments

Previous rejections that are not reiterated herein are withdrawn.

Election Requirement

Applicant's traversal of the election requirement, which was not a restriction, is noted.

However, it was noted that when the elected species is found allowable, the search would be extended to other species that are not elected. However, also, applicant elected claims 29-36, 38-41 and 43 as reading on applicant's elected cosmetic in the form of nail care from claim 41 and excipient from claim 40. It is respectfully noted that applicant did not elect a specific excipient from the list. Regarding burden, it is noted that the examiner would have to search, for example, a hydrophilic cationic component claims 37 and 42. Therefore, claims 29-36, 38-41 and 43 are examined.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 30-36 and 38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the

relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is written description.

A lack of adequate written description issue arises if the knowledge and level of skill in the art would not permit one skilled in the art to immediately envisage the product claimed from the disclosed process. See, e.g., Fujikawa v. Wattanasin, 93 F.3d 1559, 1571, 39 USPQ2d 1895, 1905 (Fed. Cir. 1996). In the present case, the claimed invention in claim 30 recites “at least one hydrophilic component.” The specification at paragraphs [0043] and [0044] of the published application guides one to appreciate what applicant intends the hydrophilic component to be in at least structural sense but the guidance derived from the instant specification points to hydrophilic component that is defined solely by function terms without describing in concrete terms and structures what the components are. For example, water is hydrophilic so also is a host of other hydrophilic components such that the artisan would have to screen every component that is hydrophilic to arrive if at all at what applicant regards as hydrophilic component. Defining hydrophilic component strictly only by functional terms appears to lead the artisan on a hunting expedition.

An applicant may also show that an invention is complete by disclosure of sufficiently detailed, relevant identifying characteristics which provide evidence that applicant was in possession of the claimed invention, i.e., complete or partial structure, other physical and/or chemical properties, functional characteristics when coupled with a known or disclosed correlation between function and structure, or some combination of such characteristics. This is lacking in the instant case

The written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species by actual reduction to practice, reduction to drawings, or by disclosure of relevant, identifying characteristics, i.e., structure or other physical and/or chemical properties, by functional characteristics coupled with a known or disclosed correlation between function and structure, or by a combination of such identifying characteristics, sufficient to show the applicant was in possession of the claimed genus. See Eli Lilly, 119 F.3d at 1568, 43 USPQ2d at 1406. This is also lacking in the instant case.

A "representative number of species" means that the species, which are adequately described are representative of the entire genus. Thus, when there is substantial variation within the genus, one must describe a sufficient variety of species to reflect the variation within the genus. The disclosure of only one species encompassed within a genus adequately describes a claim directed to that genus only if the disclosure "indicates that the patentee has invented species sufficient to constitute the gen[us]."

Applicant has not provided a description of the structure or chemical name of a representative number of compounds. In other words, the Applicant has not described with sufficient clarity a hydrophilic component that is the claimed invention.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 29-32, 34, 36, 40, 41 and 43 are rejected under 35 U.S.C. 102(b) as being anticipated by de la Poterie et al. (US 5,972,354).

de la Poterie discloses cosmetic composition in the form of lipstick or foundation as recited in instant claim 41 (column 1, lines 9-14, 40-54) for application to the skin (column 1, line 9); the application of the composition meets the instant method of applying the composition to the skin. de la Poterie discloses the formation of a film over the skin or the lip upon applicant of the composition (column 1, lines 40-49), which meets film formation over the skin as in instant claim 1. The composition that is applied to the skin to form the film comprises polyester polyurethane, siloxane or organic compound having a sulfonic group, ethylene diamine that meets the chain extender limitation of the claims, glycols that meet the limitation of hydrophilic compound (column 3, lines 13-64) and dyes and pigments (column 5, line 62 to column 6 line 26) such that de la Poterie meets claims 29-32, 34, 36, 40, 41 and 43.

5. Claims 29-32, 34, 36, 40, 41 and 43 rejected under 35 U.S.C. 102(e) as being anticipated by Kantner et al. (US 6,433,073) or Scholz et al. (US 6,605,666).

Kantner discloses polyurethane dispersion containing isocyanate terminated polyurethane having the structure in instant claims 38 and 43 (abstract; column 4, lines 13-19; column 9, lines 38-67); ethylene diamine (column 4, line 17) meeting the chain extender of claims 30 and 34; mixture of alcohol and water (column 4, line 10) meeting the hydrophilic compound of claim 30; diisocyanate and polyester diol (column 4, lines 15-17) meeting the isocyanate and diol limitations of claims 30-32; the polyols of Kantner have molecular weight of 62 to 10,000, preferably 200 to 5,000, and most preferably from 400 to 3,000 (column 6, lines 41-43) meeting

claim 33; the composition is applied to the skin as foundation, moisturizer and is also applied to the nails (column 5, lines 21, 29-37) and when applied, the application process meets the generic method claims 29 and 30, the composition dries to a film of about 0.025 millimeter in thickness (claim 18) meeting instant claim 39. Therefore, Kantner anticipates the claims as designated.

Scholz discloses composition that is applied to the skin, which dries to 0.025 millimeter film in thickness (column 3, lines 41-50 and 61; claim 19) meeting claims 29 and 39. The composition of Scholz is a dispersion comprising silyl terminated polyurethane (column 9, lines 34-66), polyisocyanates, tetramethylene diisocyanate (column 7, line 55 to column 8 line 4), alcohol-water mixture (column 8, line 17) and carbowax (column 10, lines 21-30) that meets hydrophilic compound; polyalkylene diols or tetrols or triols (column 10, lines 4 and 43) or polyester diols, triols, or tetrols (column 10, line 44) that meet claims 29, 31 and 32; alkylene diamines (column 10, lines 43 and 44) that meet the chain extender of claim 34; surfactant (column 10, lines 25-34) as in instant claim 40. Scholz meets the claims.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting

ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 29-32, 34, 36, 40, 41 and 43 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-26, 1-29 of U.S. Patent Nos. 6,433,073 B1 and 6,605,666 B1 respectively. An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claims are not patentably distinct from the reference claims since the examined claims are either anticipated by or would have been obvious over the reference claims. See e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). Although the conflicting claims are not identical, they are not patentably distinct from each other because the issued claims apply the same composition to the skin.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is (571) 272-0594. The examiner can normally be reached on 7 a.m. to 5:30 p.m. (Monday to Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Blessing Fubara
Patent Examiner
Tech. Center

